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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,292	06/12/2001	Takahisa Shirakawa	F-11210	3055

30743 7590 03/10/2005

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EXAMINER

DALENCOURT, YVES

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,292

Applicant(s)

SHIRAKAWA, TAKAHISA

Examiner

Yves Dalencourt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is responsive to election requirement filed on 11/01/2004.

Election/Restrictions

Applicant's election without traverse of claims 1 - 8 in the reply filed on 11/01/2004 is acknowledged.

Specification

The disclosure is objected to because of the following informalities: It is suggested to change " replay "([0025, lines 2 and 4) to --reply --; and "In Replay-To " ([0028], line 4) to -- In Reply to --.

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (paragraphs 0029 – 0032; 0034, 0036 – 0038). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Appropriate correction is required.

The abstract is objected to because it contains legal phraseology, such as " means " (page 19, lines 5 and 9). It is suggested to delete the numbers in the abstract.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The

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abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 4 and 6 – 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Dickie et al (US 6,643,687).

Regarding claim 1, Dickie teaches an electronic mail transfer device for relaying an electronic mail transmitted from a transmission terminal through a communication line and transferring the electronic mail thus relayed to a reception terminal (fig. 5; col. 5, lines 3 – 14; Dickie discloses a client component 410 and a server component 420 communicate in a cooperative manner to send and receive email), comprising means for converting to another electronic mail address the electronic mail address of the transmission source of the electronic mail which is transmitted from said transmission terminal through said communication line and then transferring the electronic mail to said reception terminal (col. 5, lines 54 – 62; col. 6, lines 17 – 23; Dickie discloses a

proxy email address corresponding but not equivalent to the actual email of the sender, may be presented to the recipient for replying to the email message); and means for converting the address of a transmission destination of a reply electronic mail to the address of the transmission source before the address conversion and then transferring the reply electronic mail to said transmission terminal when the reply electronic mail to the electronic mail is transmitted from said reception terminal (col. 5, lines 14 – 34; col. 6, lines 13 – 17; Dickie discloses that an email address is generated by the email system 400 that is a proxy address for sending an email to a recipient from the sender. The proxy email address corresponds to the recipient's actual email address).

Regarding claim 2, Dickie teaches the electronic mail transfer device of claim 1, which further comprising: means for storing the electronic mail address of the transmission source of the electronic mail transmitted from said transmission terminal and information appending to the electronic mail in a memory while the electronic mail address and the information are associated with each other (col. 5, lines 3 – 42; col. 6, lines 10 – 25; Dickie discloses that server system 40 is coupled to a storage element 230 for storing a database 430 of the proxy addresses for each sender recipient pair; and means for referring to said memory and extracting the electronic mail address of the transmission source of the electronic mail transmitted from said transmission terminal on the basis of the information appending to a reply electronic mail transmitted from said reception terminal (col. 5, lines 3 – 42; col. 6, lines 10 – 25; Dickie discloses that server system 40 is coupled to a storage element 230 for storing a database 430 of the proxy addresses for each sender recipient pair).

Regarding claim 3, Dickie teaches the electronic mail transfer device of claim 1, wherein the another electronic mail address contains the address allocated to said electronic mail transfer device (col. 5, lines 14 – 24; Dickie discloses the proxy address generated by the email system 400 that is a proxy address for sending an email to a recipient from the sender).

Regarding claim 4, Dickie teaches the electronic mail transfer device of claim 2, wherein the information appending to the electronic mail is a header of the electronic mail (col. 4, lines 1 – 7; col. 5, lines 25 – 30; Dickie discloses a proxy email address generated such as userid@mailsystem.ext or xx12789@serversystem.ext, where “userid or xx12789” is the header as claimed, that identifies that the email message for the project manager was originated by the particular project member).

Regarding claim 6, Dickie teaches the electronic mail transfer device of claimed in claim 1, which further comprises a transmission terminal for transmitting an electronic mail to said electronic mail transfer device (col. 5, lines 25 – 34; Dickie discloses that the email sent from the project member to the project leader is routed to server system 40 where software residing on server system 40 determines that the email address xx12789@serversystem.ext is to be mapped into the recipient's actual email address and forwarded on to the recipient); and a reception terminal for receiving an electronic mail transmitted from said electronic mail transfer device (col. 5, lines 25 – 34; Dickie discloses that the email sent from the project member to the project leader is routed to server system 40 where software residing on server system 40 determines that the

email address xx12789@serversystem.ext is to be mapped into the recipient's actual email address and forwarded on to the recipient).

Regarding claim 7, Dickie teaches the electronic mail transfer device of claimed in claim 1, which further comprises a transmission terminal for transmitting an electronic mail through a communication line to said electronic mail transfer device (col. 2, lines 60 – 62; col. 3, lines 3 - 21).

Regarding claim 8, Dickie teaches the electronic mail transfer device of claimed in claim 1, which further comprises a reception terminal for receiving an electronic mail transmitted from said electronic mail transfer device through a communication line (col. 2, lines 60 – 62; col. 3, lines 3 - 21).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dickie et al (US 6,643,687) in view of Balijepalli et al (US 20004/0230566; hereinafter Balijepalli).

Regarding claim 5, Dickie teaches substantially all the limitations, including a database entry for the recipient's proxy email address that includes a counter, which can be incremented or decremented in order to limit the number of email exchanges for the proxy email address (col. 6, lines 55 – 65; paragraph bridging col. 6, line 65 through

col. 7, line 2), but fails to specifically teach the idea of canceling the information appending to the electronic mail from said memory when the number of reply electronic mails exceeds a predetermined number.

However, Balijepalli teaches, in an analogous art, a web-based customized information retrieval and delivery method and system, which comprises means for canceling the information appending to the electronic mail from said memory when the number of reply electronic mails exceeds a predetermined number (paragraph 0031; Balijepalli discloses that if the reply message is sent (indicating unsuccessful delivery of the message), e.g. 3 times in a row, the corresponding account is suspended and email messages are no longer delivered thereto).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dickie's device by canceling the information appending to the electronic mail from said memory when the number of reply electronic mails exceeds a predetermined number as evidenced by Balijepalli (see paragraph [0031]. One having ordinary skill in the art would have been motivated to use the teachings of Dickie, wherein the database entry for the recipient's proxy email address would include a counter, which can be incremented or decremented in order to limit the number of email exchanges for the proxy email address (col. 6, lines 55 – 65; paragraph bridging col. 6, line 65 through col. 7, line 2), with the teachings of Balijepalli by providing the use of suspending automatically the electronic delivery of information to electronic mail destination having invalid electronic mail addresses for the purpose of preventing future

communication with such electronic mail addresses; thereby providing an enhanced and reliable delivery information system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Leonard et al (US Patent Number 6,721,784) discloses a system and method for enabling the originator of an electronic mail message to preset an expiration time, date, and/or event, and to control and track processing or handling by all recipients.

Contact Information

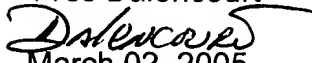
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (571) 272-3998. The examiner can normally be reached on M-TH 7:30AM - 6: 00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yves Dalencourt



March 02, 2005